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10/065,283	09/30/2002	John F. Braun	F-523	5698

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EXAMINER

OSBORNE, LUKE R

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/065,283

Applicant(s)

BRAUN ET AL

Examiner

Luke Osborne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Status***

1. Claims 1-8 have been presented for reconsideration in view of Applicant's arguments, Claims 9-20 are new have been added by Applicant's response dated 1/6/05. Claims 1-20 are now pending in this Application.

### ***Response to Arguments***

#### ***Arguments Found Persuasive***

2. Applicant's arguments dated 1/6/05 have been fully considered. The following Rejections/Objections/Advisements are substantially withdrawn and the arguments to such are persuasive. The Examiners response is as follows.

3. The Examiner acknowledges Applicant's amendment regarding the **Abstract**, **Claim 7**, and the **Specification**, consequently, the objections have been **withdrawn**.

#### ***Arguments Pertaining to Previously Presented Claims***

##### **Claim 1**

##### **Applicant Primarily Argues**

Rhoads '212 does not describe identifying a version of a form, but merely discusses embedding a unique document identifier that may include document version information ... and that such a system does not teach or fairly suggest a form version database.

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### **Examiners Response**

The Examiner makes the point that the art as applied teaches the claimed limitations and directs applicant to the previous Office Action where Rhoads '212 teaches a database [a database can be used to track documents and revisions (Paragraph 55, lines 9-10)]. The Examiner also points out that a database containing document revision numbers each of which have a unique identifier, and the identifier includes document version information is reasonably interpreted as a form version database as claimed.

### **Applicant Further Argues**

Applicants also respectfully disagree with the Examiners apparent Official Notice that it is common to update remote databases as applied. For example, Rhoads 1212 does not describe or suggest a distribute database such as currently claimed.

### **Examiners Response**

The Examiner notes that Rhoads '212 does not expressly teach the limitation of "determining if the form version database must be updated" hence the reason for taking official notice. To further clarify the current rejection and to refute Applicant's assertion that this limitation was not well known the Examiner presents U.S. Patent No. 5,684,990 "Synchronization of Disparate Databases" by Boothby. See the abstract of the invention for the concept of database synchronization for which the claimed limitation pertains.

### **Applicant Further Argues**

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Applicants respectfully submit that the references are not properly combined. Rhoads '212 does not contemplate a pointing instrument at all and certainly does not contemplate forms that may be filled in using a pointing instrument such as a digital pen

### **Examiners Response**

In response to applicant's argument above, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### **Applicant Further Argues**

Amended claim 1 recites: processing pointing instrument input data obtained using the form if the form is an acceptable version.

Rhoads '212 does not teach or suggest such a fillable form.

Regarding claim 7, Applicants respectfully submit that all claim terms must be considered in determining patentability.

Regarding claim 8, Rhoads '212 does not even contemplate a pointing device or a fillable form version database.

### **Examiners Response**

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The combination of Roads '212 with Ericson '376 as applied previously to claim 1, teaches the amended limitation of "processing pointing instrument input data obtained using the form if the form is an acceptable version" as previously stated Roads

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'212 can determine whether the form is an acceptable version. Processing the pointing instrument input data can be found in Ericson '376 Column 19, line 55 – Column 20 line 32 where the user fills in the fields for sending an email.

## ***Rejections to the Claims Based on Applicant's Amendment***

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-2, 5-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads of record, in view of Ericson of record. Unless otherwise noted all references are to the primary reference of Rhoads.

Per claim 1, Rhoads discloses a method for identifying a version of a form. See Figures 1, 2A-C, and 5 and the corresponding portions of Rhoad's specification for this disclosure. In particular Rhoads teaches a method for identifying a version of a form comprising:

- initializing a client [handheld computer 10] having a form version database [a database can be used to track documents and revisions, (Paragraph 55, lines 9-10)];
- determining if the form version database must be updated [it is common in the art of distributed databases to update the remote database];
- and obtaining form version data [watermark] from the form; and
- determining whether the form is an acceptable version using the form version database and the form version data [the document data (watermark) is compared with the database information to determine whether the printed copy is the most recent copy (Paragraph 57, lines 1-3].

Rhoads does not explicitly disclose that the client is a pointing instrument [However, Rhoads recognizes that any improved components may be suitably interchanged with their invention. (Paragraph 26, lines 11-12)]

Ericson discloses a method similar to Rhoads, in which both interface with physical paper using handheld computing devices. Both systems are also able to

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determine the version of the document at hand. See Figures 1, 3, 7, 8 and 9 and the corresponding portions of Ericson's specification for this disclosure. In particular, Ericson's system uses a pointing device, more specifically a pen as the handheld computer [Ericson : Figure 7].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use Ericson's pen computer with the method of Rhoads with the motivation as discussed above.

The combination as presented above teaches the claimed limitation of processing pointing instrument input data obtained using the form if the form is an acceptable version Ericson '376 Column 19, line 55 – Column 20 line 32 where the user fills in the fields for sending an email.

Per claim 2, the system and method of Rhoads in view of Ericson as applied to claim 1 above discloses the claimed invention. See Ericson Figures 1, 3, 7, 8 and 9 and the corresponding portions of Ericson's specification for this disclosure. In particular, wherein the pointing instrument is a digital pen [Ericson: Figure 7, and Figure 8 item 81].

Per claim 5, the system and method of Rhoads in view of Ericson as applied to claim 2 above discloses the claimed invention. In particular, wherein the form version data is obtained by obtaining user stroke data [A hand-written entry can constitute a third information layer (Ericson: Column 3, lines 66-67)].



Per claim 6, the system and method of Rhoads in view of Ericson as applied to claim 5 above discloses the claimed invention. In particular, wherein the user stroke data is obtained when the user traces over a form indicator [Ericson: function field (Column 4, lines 61-65)].

Per claim 7, the system and method of Rhoads in view of Ericson as applied to claim 6 above discloses the claimed invention. In particular, wherein the form indicator is a serial number pre-printed [absolute position coding pattern 9 (Ericson: Column 6, lines 39-40)] on the form in a dashed font. The limitation “dashed” is considered to be a design choice and given no patentable weight. Instead of a dashed font to distinguish the serial number it could be in bold, grayscale, or a different color.

Per claim 8, the system and method of Rhoads in view of Ericson as applied to claim 1 and 2 above teaches the claimed invention. In particular, a digital pen comprising [See the discussion regarding claim 2 above]:

- a processor [CPU (Fig. 1, item 12)];
- a storage device connected to the processor [Memory (Fig. 1, item 14)]; and
- the storage device storing a form version database [a database can be used to track documents and revisions, (Paragraph 55, lines 9-10)].

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Regarding claim 9 (new) the system and method of Rhoads in view of Ericson as applied to claim 8 teaches the digital pen of claim 8. In particular, Rhoads further teaches, wherein:

- the processor is configured to update the form version database [The movie theater decoder can download a list of authentic payloads or identifiers prior to each movie showing or session (Paragraph 0064)].

Regarding claim 10 (new) the system and method of Rhoads in view of Ericson as applied to claim 9 teaches the digital pen of claim 9. In particular, Rhoads further teaches, wherein:

- the processor is configured to obtain a form version number and to use the form version database to determine if the form version number is acceptable [The extracted identifier can be compared to the authentic identifiers to confirm a valid ticket (Paragraph 0064)].

Regarding claim 11 (new) the system and method of Rhoads in view of Ericson as applied to claim 10 teaches the digital pen of claim 10. In particular, Rhoads further teaches, wherein:

- the processor is configured provide an indication to a user if the form version number is not acceptable [The decoder verifies authentic tickets by opening a gate or enabling a visual confirmation, e.g., a green light (Paragraph 0064)].

Regarding claim 12 (new) the system and method of Rhoads in view of Ericson as applied to claim 11 teaches the digital pen of claim 11. In particular, Rhoads further teaches:

- an LED for providing an indication to the user [The decoder verifies authentic tickets by opening a gate or enabling a visual confirmation, e.g., a green light (Paragraph 0064) For the examination of this claim the Examiner has presumed that LED = Light Emitting Device].

Regarding claim 13 (new), Rhoads in view of Ericson as applied to claim 1, teaches claim 1. In particular, Rhoads further teaches, the method of claim 1 further comprising:

- updating the form version database periodically [The movie theater decoder can download a list of authentic payloads or identifiers prior to each movie showing or session (Paragraph 0064)].

Regarding claim 14 (new), Rhoads in view of Ericson as applied to claim 2, teaches claim 2. In particular, Rhoads further teaches, the method of claim 2 further comprising:

- disabling the digital pen if the form version database must be updated [The movie theater decoder can download a list of authentic payloads or identifiers prior to each movie showing or session (Paragraph 0064) If the

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decoder was unable to get the updated list it can not perform its task and is therefore disabled].

Regarding claim 15 (new), Rhoads in view of Ericson as applied to claim 2, teaches claim 2. In particular, Rhoads further teaches, the method of claim 2 further comprising:

- signaling a source of forms if the form is not an acceptable version [query an online database to verify each ticket (Paragraph 0064)].

Regarding claim 16 (new), Rhoads in view of Ericson as applied to claim 2, teaches claim 2. In particular, Rhoads further teaches, the method of claim 2 further comprising:

- the form version data is obtained by obtaining lookup pattern data [The extracted identifier can be compared to the authentic identifiers to confirm a valid ticket. When the ticket identifier matches one of the authorized identifiers, the ticket is verified (Paragraph 0064)].

6. Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads of record, in view of Ericson of record as applied to claim 2 above, and further in view of Seder of record. Unless otherwise noted all references are to the primary reference of Rhoads.

Per claim 3, the system and method of Rhoads in view of Ericson as applied to claim 1 and 2 above in view of Seder discloses the claimed invention. In particular, wherein the form version data is obtained by scanning an RF-ID tag [watermark].

The system and method of Rhoads in view of Ericson does not teach that the identification watermark could be in the form of an RF-ID tag.

Seder discloses a similar watermarking system to Rhoads modified by Ericson in that they both use identification watermarks to identify documents. See Seder Figure 7 and the corresponding portions of Seder's specification for this disclosure. In particular Seder discloses that [other technologies can alternatively be employed. These include barcodes, data glyphs, RFID devices, magnetic stripes, organic transistors, smart cards, etc. (Seder: Paragraph 77, lines 2-5)].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use alternative methods to identify documents as evidenced by Seder above.

Per claim 4, the system and method of Rhoads in view of Ericson as applied to claim 1 and 2 above in view of Seder discloses the claimed invention. In particular, wherein the form version data is obtained by scanning a bar code [watermark].

The system and method of Rhoads in view of Ericson does not teach that the identification watermark could be in the form of a bar code.

Seder discloses a similar watermarking system to Rhoads modified by Ericson in that they both use identification watermarks to identify documents. See Seder Figure 7

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and the corresponding portions of Seder's specification for this disclosure. In particular, Seder discloses that "other technologies can alternatively be employed. These include barcodes, data glyphs, RFID devices, magnetic stripes, organic transistors, smart cards, etc." [Seder: Paragraph 77, lines 2-5].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use alternative methods to identify documents as evidenced by Seder above.

7. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads of record, in view of Ericson of record, and further in view of Seder of record.

Regarding claim 17 (new) Rhoads in view of Ericson further in view of Seder teaches the claimed invention. Rhoads teaches a method for authorizing the use of a version of a form comprising:

- initializing a client [handheld computer 10] having a form version database [a database can be used to track documents and revisions (Paragraph 55, lines 9-10)];
- obtaining form version data [watermark] from the form; and
- determining whether the form is an acceptable version using the form version database and the form version data [the document data (watermark) is compared with the database information (Paragraph 57, lines 1-3)];

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Rhoads does not explicitly disclose that the client is a pointing instrument [However, Rhoads recognizes that any improved components may be suitably interchanged with their invention. (Paragraph 26, lines 11-12)] or

*Authenticating a user of the pointing instrument;*

*Determining whether the user is an authorized user of the form version using the form version database.*

Ericson discloses a method similar to Rhoads, in which both interface with physical paper using handheld computing devices. Both systems are also able to determine the version of the document at hand. See Figures 1, 3, 7, 8 and 9 and the corresponding portions of Ericson's specification for this disclosure.

In particular, Ericson's teaches a *pointing instrument*, more specifically a pen as the handheld computer [Ericson : Figure 7].

It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to use Ericson's pen computer with the method of Rohads with the motivation as discussed above.

Ericson further teaches *authenticating a user of the pointing Instrument* such as that a hand-written entry can constitute a third information layer (Ericson: Column 3, lines 66-67) this information not only fills in the form but can also identify a user.

– authenticating a user of the pointing Instrument (Ericson: Column 3, lines 66-67);

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Rhoads in view of Ericson does not expressly teach *determining whether the user is an authorized user of the form version using the form version database*.

Seder discloses a similar watermarking system to Rhoads modified by Ericson in that they both use identification watermarks to identify documents. See Seder Figure 7 and the corresponding portions of Seder's specification for this disclosure. In particular, Seder teaches that a variety of technologies can be used to identify and authenticate [Seder: Paragraph 77, lines 2-5]. Figure 10 also teaches that the Validation key S60 (watermark), is used to determine access thereby *determining whether the user is an authorized user of the form version using the form version database*.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the validation scheme of Seder with the combined method of Roads modified by Ericson.

The motivation for doing so would have been to reduce the validation key hardware by validating the user by their writing.

Regarding claim 18 (new), the combination applied to claim 17 above teaches the method of claim 17. In particular, Ericson further teaches wherein:

- the pointing instrument is a digital pen [Ericson: Figure 7, and Figure 8 item 81].

Regarding claim 19 (new), the combination applied to claim 18 above teaches the method of claim 18. In particular, Seder further teaches further comprising:



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- disabling the digital pen if the user is not an authorized user of the form version [Figure 10, Deny Access].

Regarding claim 20 (new), the combination applied to claim 17 above teaches the method of claim 17. In particular, Ericson further teaches wherein

- initializing the pointing instrument includes determining if the form version database must be updated [Changes in inventory can be updated in real-time: In another embodiment, compliant devices periodically communicate with the central computer. In still another embodiment, a handheld computing device maintains the central database. Inventory can be tracked efficiently as such. (Paragraph 0045)].

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Osborne whose telephone number is (571) 272-4027. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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